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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/315,918	05/20/1999	KWAN-HO CHAN	CHAN-23	7107

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EXAMINER

ROBERT, EDUARDO C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 03/06/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/315,918	<b>Applicant(s)</b> CHAN, KWAN-HO	
	<b>Examiner</b> Eduardo C. Robert	<b>Art Unit</b> 3732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-17,19-23 and 29-48 is/are pending in the application.
- 4a) Of the above claim(s) 19-23 and 29-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9-17 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of Invention I, claims 1, 3-17, in Paper No. 13 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without traverse** (MPEP § 818.03(a)).

Claims 19-23 and 29-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. The election in Paper No. 13 has been treated as an election **without traverse**.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3, 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Curtis, et al.

Curtis, et al. disclose an apparatus represented in figures 1 and 2 comprising a jamming retainer 11 having a longitudinal bore. The apparatus further comprises a suture retainer 14 which has a tapered shape and is received in the longitudinal bore of the jamming retainer 11

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(see col. 2, lines 35-37). The apparatus can be made from stainless steel or titanium (see col. 3, lines 16-18). Curtis, et al. further disclose that the apparatus is used with a suture that attaches a soft tissue to bone, and that the jamming retainer retains the suture and soft tissue and the jamming retainer is secured to the bone (see col. 1, lines 5-19, and col. 2, lines 20-40).

Claims 1 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Boucher, et al.

Boucher, et al. disclose an apparatus comprising a jamming retainer 116 fixed in a bone tunnel with an interference screw 152. The jamming retainer 116 has exterior threads which correspond to threads of the interference screw 152. The jamming retainer is tapered (see Figure 7).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curtis, et al.

Curtis, et al. disclose the claimed invention except for the jamming retainer having a spherical shape. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the jamming retainer of Curtis, et al. having a spherical shape, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art

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would find obvious for the purpose of enhance fixation of a ligament in a bone tunnel. *In re Dailey and Eilers*, 149 USPQ 47 (1966).

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curtis, et al. in view of Pierce.

Curtis, et al. disclose the claimed invention except for a loop for receiving a ligament or tendon. Pierce discloses a jamming retainer 15 with a suture B to retain ligament, tendons, or soft tissue. The suture B is formed in a loop to held fast the soft tissue to the bone (see Figure 31). It would have been obvious to one skilled in the art at the time the invention was made to make a loop with the suture of Curtis, et al. in view of Pierce, in order to ensure that the soft tissue is held to the bone.

### ***Response to Arguments***

Applicant's arguments filed on 10/04/00 have been fully considered but they are not persuasive.

In response to applicant's argument that claim 1 is limited to an apparatus "for augmenting an interference screw fixation, wherein the interference screw engages a wall of the bone tunnel", it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, **the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations.** *Ex parte Masham*, 2 USPQ2d 1647 (1987). With regard to applicant's argument that the jamming retainer

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is “adapted to” be engaged by an interference screw, it is noted that it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. In this case the jamming retainer is capable of performing the function of being engaged by an screw.

In response to applicant’s argument that Boucher’s device uses the wedge for engaging the ligament, rather than utilizing the screw to engage the ligament, it is noted that the fact that Applicant uses the screw for a different purpose does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose disclosed in the reference. Moreover, with regard to the recitation in claim 1 of “for augmenting an interference screw fixation wherein the interference screw engages a wall of the bone tunnel and engages the ligament in the bone tunnel”, it is noted that it has been held that **a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.** Ex parte Masham, 2 USPQ2d 1647 (1987).

#### *Allowable Subject Matter*

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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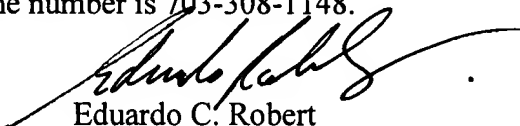
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333.

The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 703-308-2698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C. Robert  
March 4, 2002